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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/820,554
Filing Date: March 29, 2001
Appellant(s): MAEHIRO, KAZUTOYO

Bruce H. Bernstein
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed on Dec. 22, 2006 appealing from the Office action mailed on Jan. 20, 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

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(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings, which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,433,795	MacNaughton et al.	8-2002
6,193,610	Arimilli et al.	2-2001

(Note: Since the '795 patent is subject to a terminal disclaimer filed on record and claimed the priority of the U.S. Patent No. 5,796,393 filed on Nov. 8, 1996).

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-13, 15-28 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over by MacNaughton et al. (U.S. Patent No. 6,433,795) of record, further in view of Junkin (U.S. Patent No. 6,193,610).

As to claims 1, 15-16 and 30, MacNaughton et al. (hereinafter referred as MacNaughton) discloses a computer system [e.g., see Abstract, Fig. 1] with apparatus, methods and computer program products as claimed by applicant, to perform the following processing, comprising:

a) a membership information retrieval server [e.g., see the Community Server (18), Fig. 1A-B] accepts requests from a group of user terminals [e.g., see the user's terminal with Web browser (10), Fig. 1A] via the Internet communication protocols [e.g., TCP/IP (16, 34), or HTTP or FTP or IRC, etc; col. 6, lines 35-37] to perform the following functions, comprising:

* storing the membership information from a group of users to a storage device [e.g., see col. 5, lines 39-42, col. 8, lines 28-37; the Membership Database (44), Fig. 1B], therein the membership information is updated dynamically by the user [e.g., col. 8,

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lines 33-46] and comprising video game information entered into and sent from each of the user terminals [e.g., col. 7, line 16; col. 8, lines 47 – col. 9, line 66].

* retrieval and searching selected membership information from the storage device in respond to the request from the system user [col. 1, lines 61-65; col. 8, lines 2-23; col. 9, lines 50-66], wherein the selected membership information corresponding to online and offline users [e.g., the results returned by on-line transactions such as CwholsHereTrackReq, CwholsHereTrackRsp, CinviteTrackReq, CinviteTrackRsp, etc. provided at col. 19, table I & II that was executed by the community server, tracking server, and SQL server of Fig. 4];

* displaying the membership information sent from the server on display of the user terminals [col. 2, lines 19-23];

* communicating to one or more members in the created temporary user list via messages flow entered by a user in a client/server model. [e.g. see the “who’s Online”, the real-time “Chat” and “Invitations” communication message services offered in a client(user)/server model as recited at col. 9, lines 3-45] wherein, a second temporary user list that is associated with the invitation action can be created by using extended scripting language [e.g., col. 23, line 32 – col. 24, line 3, Fig.(s) 4-6 and associated texts].

Although MacNaughton discloses that the membership information entered into and sent from each of the user terminals including system membership status [e.g., col. 14, Login and Logout fields of the various request type table] for an on-line subscribers

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Internet service system [e.g., Abstract, lines 1-6], he did not specifically disclose that the membership information having the updated video game status.

However, Junkin discloses an interactive system having the updated video game status as claimed by applicant [e.g. Abstract; Fig(s). 4 A-B and associated texts; col. 8, lines 48 – col. 9, line 28; col. 10, lines 12-35].

MacNaughton and Junkin are both of the same field to facilitate on-line Internet communication services including video games. Therefore, with the combined teachings of MacNaughton and Junkin in front of him/her, an ordinary skilled artisan at the time the invention was made would be motivated to further modify the combined system with the video game status as claimed by applicant, because by doing so, the modified system will provide a user friendly real-time game status and allows the player to make selections as desired.

As to claims 2-13 and 17-28, except the features recited in claims 1, 15-16 and 30, the combined system of MacNaughton and Junkin further discloses that the system having the features as claimed by applicant, including:

a) a determination system [e.g., MacNaughton: the unit148, Fig. 4] that determines whether each of the group of the user terminals is current online [e.g., MacNaughton: see the unit150, Fig. 4], wherein the communication server [e.g., MacNaughton: the unit 140, Fig. 4] imports the determination results into the membership information and then sends the membership information to the user terminal [e.g., MacNaughton: col. 8, lines 43-65; Fig. 4; col. 16, lines 15 - 48];

b) the membership information includes user name, text , etc, which can be updated whenever necessary from the user terminal online activities [e.g., MacNaughton: col. 8, lines 14-46; Junkin: col. 10, lines 12-35].

(10) Response to Argument

Applicant's arguments filed on November 17, 2006 have been fully considered but they are not persuasive.

The examiner disagrees with appellant's piecemeal interpretation and arguments against the 35 U.S.C. § 103(a) rejections.

The Applicant's Invention:

A computer-implemented system and method are provided to retrieve on-line inactive video game playing membership information from a database, update and display video game status via network notification messages.

Appellant arguments are summarized as followings:

1) Applicant argued that the prior art of record, taken individually or in combination, are non-analogous or no motivation to combine. The examiner respectfully disagrees.

In reply to arguments 1), It appears as if the appellant is attacking the references in a piece meal fashion, instead of in combination, as intended by the Examiner and as shown above in the rejections under 35 USC § 103(a). Therefore, in response to

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appellant arguments against the references individually, the Office first points out that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Furthermore, as cited in the above paragraphs, the primary reference of MacNaughton specifically discloses a computer system [e.g., see Abstract, Fig. 1] comprising: a membership information retrieval server [e.g., see the Community Server (18), Fig. 1] which accepts user inputs including "Who's Online", "real time Chat", "Invitations", "email", "Games" query messages from a group of user terminals [e.g., the user's terminal with Web browser (10), Fig. 1; col. 5, lines 19 - col. 6, lines 67 and col. 7, lines 1-17] to perform the on-line services as claimed by appellant. Furthermore, MacNaughton clearly discloses the on-line community membership information is updatable via the current selected URL browsing [e.g., col. 8, lines 14-46] and the on-line community services are customizable by using scripting language for an extended toolbar control [e.g., col. 23, line 32 – col. 24, line 3, Fig.(s) 4-6 and associated texts]. Additionally, Junkin also discloses an on-line interactive video game playing system that displays the updated video game status as claimed by appellant [e.g. Abstract; Fig(s). 4 A-B and associated texts]. Hence, one of ordinary skill person in the art at the time the invention was made would in fact, contrary to appellant's arguments, look to incorporate the video game status displaying technique taught by Junkin in MacNaughton's system for constructing a combined interactive on-line service system in a client/server

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environment for searching and navigating the on-line services, such that the combined system will provide a user friendly real-time video game status and allows the users to make selections based on needs or queries entered by users. Therefore, the examiner contends that there would be most definitely a reasonable expectation of success.

2) Appellant argued that even if combined, the references fail to teach or suggest the following:

a) comparing at least one retrieval condition with the dynamically updated user-entered text messages;

b) accepting selection of members from the displayed members, creating a temporary user list including the selected members, and sending a message to the members in the temporary list as recited in claims 2, 25, 16 and 30." The examiner is not persuaded.

In reply to these arguments, the examiner directs Application's attention to the following excerpts disclosed by MacNaughton:

"Each community supported by the present invention may provide "capabilities." The actions that may be performed within a community are the communities capabilities. Capabilities represent a variety of interaction methods or options. Primary or core capabilities may include a "Community Centre" (or Home Page which introduces the user to the community), "Create or View Comments" (e.g., annotations such as threaded messages, documents, spreadsheets, etc. for a particular community), "Who's Online" (a list of members currently in the community), "Chat" (real time interactions with other community members), "Invitations" (messages from one community member to another to chat, play a game, etc.), "Help" (instructions on how to perform a particular task, for example), "Notices and Personal Messages" (e.g., email), "Internet Features" (e.g., CUCME, Internet Phone), "Games" (e.g., DOOM, Quake, Flight Simulator). Special capabilities may also be developed for a community." [col. 7, lines 1-18]

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"Users may be introduced to or notified of capabilities via "notifications." Notifications are associated with communities and indicate or reference additional information or content (i.e., Community Content) as well as interaction options or methods that may be of interest to the user. As the user continues to browse or "surf" the Web, notifications may be sent to the Community Client 14 from the Community Server 18 to let the user know what additional community capabilities or features are available for the current Web page or URL. For example, for a given URL, notifications may be sent to indicate a series of annotations exist for this page, additional community members are also at this page, and/or a real-time chat is in progress between several community members. Notifications may be viewed as temporary listings as they are determined at the time of access to the URL to reflect the current state of the community. Notifications may also be comprised of specific on-line content such as current stock quotes that the user has requested to receive at specified intervals (e.g., once a day.)" [col. 7, lines 19-33]

"Referring to FIG. 6, a screen shot of Web page 194, Community Client 196, and Community Web page 198 for a preferred embodiment of the present invention is shown. The Web page 194 associated with the URL 194 is displayed by the Web browser 190 (in this example, Microsoft's Internet Explorer) running on the user's computer. The Community Client 196 runs independently of the Web browser 190 and appears as a toolbar on the display. The toolbar of the Community Client comprises a plurality of custom control buttons. The control buttons are similar to menu commands (i.e., allow the user to perform actions), but are less obtrusive than menus and are always accessible. Each control button may provide a different type of community function. For example, one control button may allow a user to access threaded messages associated with the current URL. The messages may appear on a separate page (or window) 198 with additional control options for navigating the messages. For example, one or more control buttons on the message page may be used to move forward and backward in the message thread."

"In another example, a "Community Home Page" button control on the Community Client toolbar may be available to transport the user directly to the home page of the community Web site. The home page may serve as a place where users may go to be in an environment specially designed for their interests. Another control button on the toolbar may invoke a start/stop mechanism to enable users to start and stop the Community Client when it resides with another application such as a Web browser. Another control button may allow users to join or disassociate themselves with particular communities. Selection of certain control buttons may cause a supplemental client application (i.e., an application with an independent interface) to be invoked to facilitate certain interactions. For example, selection of a particular control button may initiate a chat session with other community members. The chat session may be initiated and managed through a separate (i.e., independent of the user's browser or Community Client) application that is invoked when the control button is selected and is stopped when the user decides to leave the

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session." [e.g., col. 23, lines 32-51]

"In a preferred embodiment of the present invention, the toolbar is extensible and dynamic so that a user may modify or tailor it to meet his or her needs or preferences. Users may extend the capabilities of the toolbar by creating new capabilities based on the primary or core capabilities provided by the present invention. As described earlier, the primary or core set of capabilities may include a Community Centre, Create or View comments, Who's Online, Chat, or Invitations. Other communities may have special capabilities in addition to the core capabilities. Using a scripting language, a user may extend the toolbar by creating a new option comprised of primary or core capabilities. For example, a user may create a "Game" capability comprised of the "Who's Online" capability and "Invitation" capability. When invoked from the toolbar, the Game capability may provide the user with a list of community users currently on-line and then invoke a game based on a another community member's acceptance of an invitation to play a game." [e.g., col. 23, lines 52 – col. 24, lines 3]

Here, MacNaughton clearly discloses that his system allows a user to interactively browse on-line services via the core capabilities provided by a toolbar control means or customize the primary or core capabilities provided by a toolbar control means to have extended capabilities meet a user's needs by using a scripting language. Wherein interactively browsing or the script language instruction entered by the user is deemed to including at least one condition either via a user query requests or by the language instructions inputted by the user in order to perform the core capabilities supported by the on-line services of the interactive system. Wherein, the system comprises a SQL database server [e.g., the unit: 156, Fig. 4] that is deemed to compare and retrieves the needed data based on user interactive inputs [e.g., Fig. 4 and associated texts]. Furthermore, the use of the toolbar control means or on-line chat session is deemed to invoke (or retrieve) the user desired information based on the on-line query condition entered by the user. In addition, MacNaughton clearly discloses that the selected game capabilities such as "Who's Online" and "Invitation" queries that

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will definitely make the system to create a temporary user list include the on-line members and get (or retrieve) member's acceptance responses for the selected members via the on-line services [e.g., the return results of CwholsHereTrackReq, CwholsHereTrackRsp, CinviteTrackReq, CinviteTrackRsp, etc. at col. 19, table 1 & II]. Moreover, the services are deemed to use on-line message notification schema as recited at col. 7, lines 18-37 or Fig.(s) 4-6 and associated texts. Thus, in contrary to applicant's arguments, the argued limitations are definitely taught by MacNaughton.

3) Appellant augured that "the applied references do not teach or suggest at least membership information stored in the storage device which is updated based on user input when one of the users desires to update as the results of changed circumstances as recited in claims 5, 8, 11, 12, 20, 23 and 26." The examiner is not persuaded.

In reply to these arguments, the examiner first points out that appellant fails to define the metes and bound of the claimed "the results of changed circumstance", as such these claims are open for reasonable art interpretation. In addition, MacNaughton clearly discloses a membership database [e.g., the unit 44, Fig. 1B] which stores membership information as recited in the above claims. Moreover, MacNaughton clearly discloses the claimed storage device which is updated based on user input when one of the users desires to update as the results of changed circumstances [e.g., col. 8, lines 14-46] which is cited as following:

"The Community Server 18 also interacts with a Membership database 44 to determine if a user belongs to the community associated with the URL. If it is determined a user belongs to a community, the user is given the opportunity to enter the community (e.g., select a control button or icon that represents the

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community). The user may then access a home page for the community, view community comments (e.g., view the annotations of the community associated with the URL), search community comments, and create or reply to community comments. A member of a community may also interact and communicate with other community members who have similar interests or shared circumstances by initiating synchronous communications such as chat or conferencing." [e.g., col. 8, lines 14-27]

"To become a member of a community, a user affirmatively requests access to a membership module which, in a preferred embodiment of the preset invention, is a standalone process that may be initiated from any one of a number of sources including a Web site, a Community Client, on-line service sign-up process, etc. During the membership process, information about the user (e.g., preferences and profile data such as name, address, age, billing information, interests and hobbies, favorite Web sites, etc.) is collected and stored in the Membership database 44. Because users complete the membership process for each community they wish to join, they may have a different profile for every community to which they belong. Users may also cancel community memberships resulting in deletion of the specific preference and profile data from the community membership database. In some cases, a user may become a member of a community automatically (i.e., without affirmatively initiating the membership process) as some communities may be open to all on-line service users or possibly, all Web users." [e.g., col. 8, lines 28-46]

As set forth above, contrary to appellant's arguments, MacNaughton's system clearly discloses his system including a community server (e.g., the unit 18, Fig. 1A) which coupled to a database (e.g., the unit 44, Fig. 1B) to update the membership information comprising the storing of on-line sign-up and canceling/deletion of the membership via the community database.

Thus, based on the discussion above, because applicant does not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections. The examiner concludes that the prior art read on the claimed features.

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For the above reasons, it is believed that the rejections should be sustained.

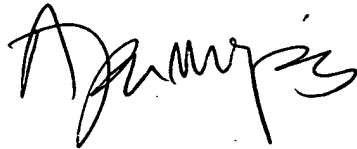
Respectfully submitted,

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